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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,245	03/27/2001	Naoaki Horiuchi	041465-5104	8060
55694 7590 05/03/2007 DRINKER BIDDLE & REATH (DC) 1500 K STREET, N.W. SUITE 1100 WASHINGTON, DC 20005-1209			EXAMINER ABEL JALIL, NEVEEN	
			ART UNIT 2165	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/817,245	Applicant(s) HORIUCHI ET AL.	
	Examiner Neveen Abel-Jalil	Art Unit 2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/2/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Remarks

1. The Amendment filed on February 5, 2007 has been received and entered. Claims 1-20 are pending.
2. Applicant's response has overcome the rejections under 35 USC 101, and 112, second paragraph.

Claim Objections

3. Claims 1-2 and 11-12 are objected to because of the following informalities:

Claims 2 and 12, recite "in order to" constitute intended use of the claimed invention. Making it never actually having to occur. Claims should be amended to recite more firm and positive language (i.e. "based on", "is", "to", "to direct"). Appropriate correction is required.

Claims 1 and 11 recite in numerous lines, the language of "for" performing a functionality all of which constitute intended use. Such language (i.e. "for") is calling for the possible intended use of the device and NOT directly calling for the "functionality" to be performed. Such language suggest that its possible to use the device in such matter but not requiring it to be used to perform the function following the "for". Thus making a option that may or may not occur falling under claim interpretations in MPEP 2173.05(h)-III. It is not the functional language that is objected to, instead, it is the intended use language in the claims.

The applicant appears to have replaced the “for” in claim 1, second limitation with “that” but neglected to do the same for all other limitations that call for “device for” etc. Claims should be amended to recite more direct and positive language such as “is”, “to”, “that”, “accumulating”, “receiving”, or “searching”, etc. Correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 2, 11, and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, and 11, line 21, recite “example information... which the user supposed to be represented by the search condition” which is confusing. Is the user (i.e. human being) being given as an example? Or is the user (i.e. human being) providing the “example”? Or is the “example” is representing a “search condition”? Or is the “search condition” representing the “example”? The Examiner can’t comprehend what is meant by the recitation as it stands. Clarification is required.

Claims 2, 11, and 12, all recite “it” and “its” without making clear what is being referenced by the “it” or “its” thus being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-6 and 11-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Cluts U.S. Patent No. 5,616,876.

As to claims 1, and 11, Cluts discloses an audio visual information processing unit comprising:

an audio visual information accumulating device for accumulating audio visual information, which includes audio visual information pieces of any one of audio information, video information and data information associated with at least any one of the audio information and the video information (See 4:36-67);

a characteristic information accumulating device that accumulates audio visual characteristic data associating the audio visual information pieces with searching parameters of each of the audio visual information pieces and search condition characteristic data associating search conditions with the searching parameters (See 11:32-47);

an inputting device for receiving a user's input of the search condition search (See 13: 14-16; and see 14: 19-25)

a search device for searching the search condition characteristic data to find the search condition thus inputted and the searching parameters corresponding to the search condition thus inputted, and when the search condition thus inputted and the searching parameters corresponding thereto are found, further searching the audio visual characteristic information to find the audio visual information piece corresponding to the searching parameters thus found (See 16:40-67);

a user learning device for receiving a user input of example information identifying at least the audio visual information piece which the user supposes to be represented by the search condition when the search condition is not found with the search device in the search condition characteristic data, searching the audio visual characteristic data to find the example information and searching parameters corresponding to the example information thus inputted, and further adding the searching parameters corresponding to the example information to the search condition characteristic data along with the search condition thus inputted with the inputting device by the user (See 19, lines 57-64); and

an outputting device for outputting the audio visual information thus found with the search device (See 16:40-67).

As to claims 2, and 12, Cluts discloses wherein

when the user learning device finds the user example information and searching parameters corresponding to the user example information thus inputted, the audio visual information piece included in the user example information is outputted to the user for user's confirmation (See 14:12-27), and

when the user's confirmation is not affirmative the inputting device is provided to input a user searching parameter in order for directly searching the audio visual characteristic data to find the user example information with its searching parameters modified by the user searching parameter (See 14:12-27), and

the user learning device further adds the searching parameters thus modified to the search condition characteristic data along with the search condition thus inputted further comprising (once its added the song list gets updated as shown in Cluts Figure 10, 1025)

As to claims 3-4, and 13-14, Cluts discloses wherein the user example information thus inputted includes a plurality of information pieces, the user learning device searches the search condition characteristic data to find the user example information pieces and searching parameters corresponding to the user example information pieces thus inputted (See 16:40-67); and

the user learning device further adds only a part of the searching parameters which is common to the searching parameters corresponding to the user example information pieces to the search condition characteristic data along with the search condition thus inputted (See 14:12-27).

As to claims 5, 6, and 15-16, Cluts discloses wherein said the outputting device outwardly outputs the audio visual information in a form of at least any one of sound and image (See 4:50-64, wherein "at least one" means prior art can cover only one option and not both).

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 7-10, and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cluts U.S. Patent No. 5,616,876.

Cluts discloses the claimed invention except for wherein said inputting device comprises a voice/example receiving device for receiving input of said search characteristic information by voice. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide wherein said inputting device comprises a voice/example receiving device for receiving input of said search characteristic information by voice since it was known in the art that using a voice with a speech to text translator would enable a user to convert his voice to be used as input to activate a computer to perform a common function such as searching for data that would allow the user the freedom of not having to use a keyboard to enter information into the computer for a response.

The Examiner maintains the rejection above; however, to expedite prosecution has presented another rejection below.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-6 and 11-16 are rejected under 35 U.S.C. 102(e) as being Syeda-Mahmood by (U.S. Patent No. 5,920,856).

As to claims 1, and 11, Syeda-Mahmood discloses an audio visual information processing unit comprising:

an audio visual information accumulating device for accumulating audio visual information, which includes audio visual information pieces of any one of audio information, video information and data information associated with at least any one of the audio information and the video information (See column 4, lines 39-51);

a characteristic information accumulating device that accumulates audio visual characteristic data associating the audio visual information pieces with searching parameters of each of the audio visual information pieces and search condition characteristic data associating search conditions with the searching parameters (See column 5, lines 39-51)

an inputting device for receiving a user's input of the search condition search (See Figure 1, 3, client browser)

a search device for searching the search condition characteristic data to find the search condition thus inputted and the searching parameters corresponding to the search condition thus inputted, and when the search condition thus inputted and the searching parameters

corresponding thereto are found, further searching the audio visual characteristic information to find the audio visual information piece corresponding to the searching parameters thus found;

a user learning device for receiving a user input of example information identifying at least the audio visual information piece which the user supposes to be represented by the search condition when the search condition is not found with the search device in the search condition characteristic data, searching the audio visual characteristic data to find the example information and searching parameters corresponding to the example information thus inputted, and further adding the searching parameters corresponding to the example information to the search condition characteristic data along with the search condition thus inputted with the inputting device by the user (See column 4, lines 39-51, and see column 7, lines 1-14, wherein “learning” reads on “user feedback” and “refining module”); and

an outputting device for outputting the audio visual information thus found with the search device (See Figure 1, 3, client browser).

As to claims 2, and 12, Syeda-Mahmood discloses wherein

when the user learning device finds the user example information and searching parameters corresponding to the user example information thus inputted, the audio visual information piece included in the user example information is outputted to the user for user's confirmation (See column 7, lines 1-14, wherein “confirmation” reads on “user feedback”), and

when the user's confirmation is not affirmative the inputting device is provided to input a user searching parameter in order for directly searching the audio visual characteristic data to

find the user example information with its searching parameters modified by the user searching parameter (See column 7, lines 1-14, wherein “confirmation” reads on “user feedback”), and

the user learning device further adds the searching parameters thus modified to the search condition characteristic data along with the search condition thus inputted further comprising (See column 4, lines 39-51).

As to claims 3-4, and 13-14, Syeda-Mahmood discloses wherein the user example information thus inputted includes a plurality of information pieces (See Figure 4, 26),

the user learning device searches the search condition characteristic data to find the user example information pieces and searching parameters corresponding to the user example information pieces thus inputted (See Figure 3, 17, refining, wherein “using inputted information” reads on performing the search with refined query), and

the user learning device further adds only a part of the searching parameters which is common to the searching parameters corresponding to the user example information pieces to the search condition characteristic data along with the search condition thus inputted (See column 4, lines 39-51, also see column 9, lines 15-21).

As to claims 5, 6, and 15-16, Syeda-Mahmood discloses wherein said the outputting device outwardly outputs the audio visual information in a form of at least any one of sound and image (See column 4, line 13, wherein Multimedia includes both sound and image).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 7-10, and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Syeda-Mahmood by (U.S. Patent No. 5,920,856).

Syeda-Mahmood discloses the claimed invention except for wherein said inputting device comprises a voice/example receiving device for receiving input of said search characteristic information by voice. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide wherein said inputting device comprises a voice/example receiving device for receiving input of said search characteristic information by voice since it was known in the art that using a voice with a speech to text translator would enable a user to convert his voice to be used as input to activate a computer to perform a common function such as searching for data that would allow the user the freedom of not having to use a keyboard to enter information into the computer for a response.

Response to Arguments

14. Applicant's arguments filed on 2/5/2007 have been fully considered but they are not persuasive.

In response to Applicant's argument that "for" performing a functionality is proper claim language indicating the functionality" is addressed in the section marked claim objections above.

In response to Applicant's argument that "Cluts's is directed to a system and NOT a unit (i.e. Apparatus)" is acknowledged but not deemed to be persuasive.

Applicant's claims state a unit that comprises many other units thus suggestions a system of networked units. No where in the claims is it suggested that the devices are all part of one computer system, even so, it is clear from Cluts's drawings, and column 6, lines 57-66, that all units are stored in one single location (i.e. server) accumulating and integrating content from various resources in one location (i.e. unit = server). The limitation was only found in the preamble, the elements of the claim does not suggest one single unit.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., extract a song out of a database inside the AV information processing unit, and also out of a network) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to Applicant's argument that "Cluts does not teach a database" is acknowledged but not deemed to be persuasive.

Cluts clearly teaches a database in column 12, lines 9-14 and Figure 1, 28, storage server.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., register new search conditions) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The claims state “adding modified search conditions” and NOT “registering new search conditions”. The word “new” is not found in any of the claims. Furthermore, there isn't enough definition in the claims to ascertain the meaning of “search condition”.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a searching function is and user learning function independently coexist to associate each other for completing a search) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In light of the other argument above that the instant application is different that Cluts in that its existing in one unit is then contradictory to this assertion by the applicant. Since in fact since they are two distinct units, then together they would form a system just as it is taught in Cluts. Furthermore, it appears as though Cluts's “more like” function performs the same functionality as the claimed user learning function since the claims do not offer any details on how the “user learning” performs its

functionality. Its not shown in the claims how “user learning” is implemented. The reading on Cluts is maintained.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. For list of Cited References, see PTO-Form 892.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074. The examiner can normally be reached on 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Neveen Abel-Jalil
April 30, 2007